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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,008	12/12/2000	Uwe Heinelt	02481.1718	3747

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EXAMINER

SACKEY, EBENEZER O

ART UNIT	PAPER NUMBER
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1626

DATE MAILED: 09/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/734,008	Applicant(s) HEINELT ET AL.	
	Examiner EBENEZER SACKEY	Art Unit 1626	

-- *Th MAILING DATE of this communication appears on the cover sheet with th correspondenc address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 15 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3, 25 and 26 is/are rejected.
- 7) ☒ Claim(s) 4-24 and 27-50 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claims 1-50 are pending.

This is a response to applicants amendment filed on 07/15/03. no amendment to the claims have been made.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as anticipated by Bondavalli et al., as stated in the last office action.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-3 and 25-26 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Bondavalli et al., for the reasons set forth in the last office action dated 04/11/03.

Response to Amendment

Applicant's arguments filed 07/15/03 have been fully considered they are not deemed persuasive with regards to applicants claim of an exo-nitrogen compound of claim 1, because the reference broadly teaches an exo-trimethylenenorbornane compound of formula (I). See table II, compound Vd.

With regards to the obviousness rejection made on 2-3 and 25-26, applicants argue that all claim elements or limitation must be taught or suggested by the prior art in order to establish a *prima facie* case. Furthermore, applicants argue that "it is impermissible within the frame work of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." The Examiner disagrees with the assertion that the identified compound of Bondavalli (compound Vd) was chosen to support a given position. Rather, it is the homologous nature of the compound. It is well settled that while homology is considered to be present even if true "homology" is not present, such does not defeat the *prima facie* case of obviousness raised by the art. Attention, in this regard is directed to In re Druey et al., 50 CCPA 1538, 319 F.2d 237, 138 USPQ 39, wherein Judge Worley, delivering the Court's opinion, stated:

"We need not decide here whether the compounds in question are properly labeled homologues. It appears to us from the authorities cited by the solicitor and appellants that the term homologue is used by chemists at times in a broad sense, and at times in a narrow or strict sense. The name used to designate the relationship

between the related compound is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound.”

Additionally, as the Court stated in In re Payne et al., 606 F. 2d 302, 203, USPQ 245 at 255 (CCPA 1979):

“the name used to designate the relationship between related compounds is not necessarily controlling; it is the closeness of that relationship which is indicative of the obviousness or unobviousness of the new compound.”

Applicants next argue that cases decided after Graham V. Deere provide guidance for analyzing the obviousness or nonobviousness of chemical invention in that prior art that does not teach “any specific or significant utility for the disclosed compounds ----- is not sufficient to render structurally similar claims *prima facie* obvious because there is no motivation for one of ordinary skill in the art to make the reference compounds, much less any structurally related compounds.” In response, the Court in In re Gyurik et al., 596 F. 2d 1012, 201 USPQ 552 at 557 stated:

“In obviousness rejections based in close similarity in chemical structure, the necessary motivation to make a claimed compound, and thus the *prima facie* case of obviousness, rises from the expectation that compounds similar in structure will have similar properties.”

Applicants further argue that the office action did not mention the limitation of claim 1 that the nitrogen be *exo*-configured. The office action cited an *endo*-amine compound, specifically, a broad class of N-substituted *exo*-5,6-trimethylenenorbornan-

2-endo-amines. Even though, the reference discloses what appears to be an endo-nitrogen as compared to the required exo-nitrogen there is nothing of record by way of unexpected results or properties that would obviate the *prima facie* case of obviousness. Moreover, applicants have not stated that the endo-amine does not possess any utility.

Applicants further argue that the Office's obviousness analysis is erroneous because (1) the reference discloses different classes of compounds, i.e., 2-endo-amines, wherein there is no suggestion that changing the structure of the nucleus of a molecule from an endo-nitrogen to an exo-nitrogen would result in a molecule having equivalent functional activity; (2) that the Office erroneously applied the general statement of utility in the reference to compound Vd relied upon to show structural obviousness because the statement regarding CNS and anti-convulsant activity is only applicable to certain amides and (3) that the reference teaches away from the selection and modification of amine compounds because the only amine compound tested (Vf) did not exhibit useful CNS or anticonvulsant activity. In response, (1) the reference did not state that there would be equivalent utility if the nucleus of the molecule is changed from an endo-nitrogen to an exo-nitrogen or vice versa; and (2) the reference does not have to test all compounds for all utilities; and (3) the reference does not need working examples or as stated previously does not need to test all compounds. Applicants next argue that claims 25 and 26 recite a method of treating ischemic states of the peripheral nervous system and ischemic states of the CNS and hence, is not the same as the amide compounds of the reference showing CNS depressant and anti-convulsant

activity. This argument is unpersuasive because as previously stated; there is nothing on record to show unobvious properties between compound Vd and applicants claimed compound. For the reasons set forth, claims 1-3 and 25-26 are again rejected.

Claims 4-24 and 27-50 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to E. Sackey whose telephone number is (703) 305-6889. The examiner can normally be reached on Monday-Friday from 7:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane, can be reached on (703) 308-4537. The fax phone number for this Group is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

EOS
September 22, 2003

Joseph K. McKane
Supervisory Patent Examiner
Art Unit 1626, Group 1600
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Alan L. Rotman
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